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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,652	05/01/2001	Vincent B. Moneymaker		4548

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,652

Applicant(s)

MONEYMAKER ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7-30-01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

Applicant's election of Group II, claims 11-20 in the reply filed on October 14, 2004 is acknowledged.

Claims 1-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 14, 2004.

Applicants are respectfully requested to cancel the non-elected claims in response to the Office Action.

Information Disclosure Statement

The information disclosure statement (IDS) was submitted on July 30, 2001, U.S. Patent No. 5,822,73 to Ogram is being considered, however, U.S. Patent No. 6,047,266 to Van Horn is not being considered because it has been withdrawn.

Drawings

The drawings filed on July 25, 2001 are acceptable.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-20 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture or composition of matter or new and

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useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a method (ex. Preamble of claim 11), the body of the claim discusses the specifics of the system (means for) and method (amalgamating...,receiving..etc.). (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). "a claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", Ex parte Lyell (17USPQ2d 1548).

Furthermore, claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. In the present case, claim 11 only recites technological arts in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In claim 11, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the

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preamble that the method is "via an electronic network". The recited steps are not directed to anything in the technological arts. The recitation of "enabling orders....."; "amalgamating orders....."; "receiving payment for....."; and "remitting funds to a....." have no structural or functional interrelationship with these method steps, which could all be performed manually by a person. Therefore, the claim is directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends the Applicant to amend the claims to better clarify which of the steps are being performed within the technological arts, such as –amalgamating order via computer electronic network which are.....--.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 11-20 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of the system (means for ...) and subsequently the claim then deals with the specifics of a method step (amalgamating...,receiving..etc.).

Claims 12-20 are rejected as being dependent on claim 11 as discussed above.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "among other things" and "or "by other means" are unclear and indefinite because it is unclear whether the limitations are including other things or other means.

Furthermore in claim 11, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-20, as best understood by Examiner, are rejected under 35**U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,324,525 to Kramer et al.**

Regarding claims 11, Kramer discloses a method of enabling facilitators (acquirer) which amalgamate electronic orders comprising; means for enabling orders to be tracked, sorted and manipulated based on whether they have been paid for in a direct electronic manner, such as by a credit card or EFT card, or indirectly by payment of cash or check to a participating merchant; amalgamating order which are paid for in a direct electronic manner and processing the orders through a single transactional gateway; receiving payment for orders which are paid for in a direct electronic manner and then applying those funds which are received to all others orders which have been enabled and tracked by the facilitator, directly to a participant who actually fulfilled the order made through the implemented electronic network system; remitting funds to a participant which remain after the deduction of fees due the facilitator for all of the orders which were enabled by the facilitator; and whereby a facilitator receives direct payment for the services provided to the participants without having to invoice the participants on an accounts receivable type basis, which would otherwise required the facilitator to wait for payment (see at least col. 18, lines 36-55; col. 131, lines 24-28; col. 133, lines 43-67; col. 132, lines 29-47; col. 134, lines 20-44).

Regarding claims 12-13, Kramer discloses the step of deducting fees due for services provided to a participant only after a sale has occurred; and the step of providing an additional services which are in addition to enabling transactions to take place in an electronically networked environment and then deducting payments due for

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these services (see at least col. 129, lines 45-56; col. 134, lines 20-27; col. 135, lines 46-51).

Regarding claims 14-20, Kramer disclose the step of enabling amalgamated data which has been processed and sorted to be exported and/or imported into software accounting programs; the step of providing and utilizing programmable computer language tags in order to enable processed and sorted transaction data to be tracked and accounted for; the step of tracking and accounting for goods and services; the step of utilizing a chart of accounts; the step of utilizing programming routines to enable transactional data; the step of utilizing separate liability and deposit accounts for each participant; and the step of utilizing a programmable routine whereby orders are sorted by payment type, as well as by participants (see at least col. 18, lines 60-64; col. 27, lines 39-43; col. 39, lines 10-15; col. 93, line 34-col. 94, line 66; col. 97, lines 15-61).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,727,243 to Savar discloses financial transaction systems for use by retail establishments.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 13, 2004


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